

REMARKS

The Official Action mailed September 27, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on June 14, 2004. The Applicants direct the Examiner's attention to U.S. Patent Application Publication No. 2004/007706 to Yamazaki et al., which was submitted in the Information Disclosure Statement filed June 14, 2004.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-15 were pending in the present application prior to the above amendment. Independent claims 1-10 have been amended to better recite the features of the present invention, and new dependent claims 16-19 have been added to recite additional protection to which the Applicants are entitled. Accordingly, claims 1-19 are now pending in the present application, of which claims 1-10 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1-10 as anticipated by U.S. Patent No. 4,888,625 to Mueller. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 1-10 have been amended to recite stacked semiconductor elements each having at least one thin film transistor, which is supported in the

specification, for example, by paragraph [0041] and Figure 3B. Mueller appears to disclose an optoelectric coupling element having a light-emitting semiconductor component 1 and a light-receiving semiconductor component 2 (Figures 1 and 2 of Mueller reproduced below).

FIG 1

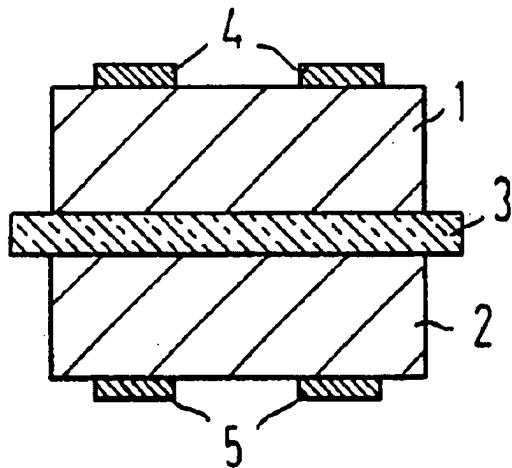
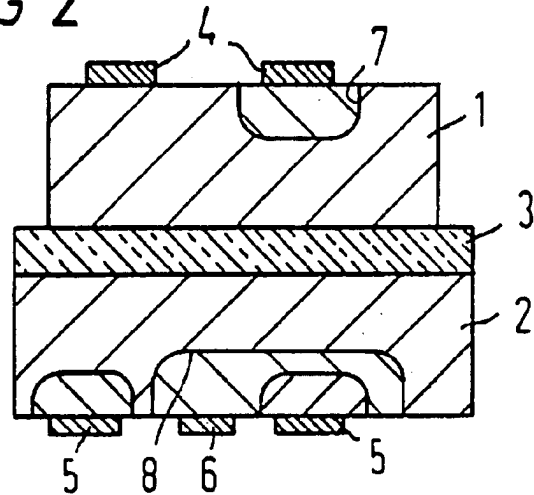


FIG 2



However, Mueller does not teach that the light-emitting semiconductor component 1 and the light-receiving semiconductor component 2 each have a thin film transistor, either explicitly or inherently.

Also, claims 9 and 10 recite a plurality of stacked thin film integrated circuits. The Official Action is silent as to whether Mueller teaches this feature, and the Applicants respectfully submit that Mueller does not teach this feature, either explicitly or inherently.

Since Mueller does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 11-15 as obvious based on Mueller. The Applicants respectfully submit that a *prima facie* case of obviousness

cannot be maintained against the independent claims of the present application, as amended.

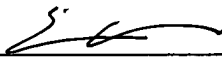
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Mueller. The Official Action asserts that it would have been obvious to use an optoelectronic coupling semiconductor device in one of the devices recited in claims 11-15 (page 3, Paper No. 050923). However, the allegedly obvious variations of Mueller do not teach or suggest stacked semiconductor elements each having at least one thin film transistor or a plurality of stacked thin film integrated circuits. Since the allegedly obvious variations of Mueller do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 16-19 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 16-19 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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